

REMARKS:

Patent Form PTO 144 is attached hereto citing two additional patents which are the subject of a PCT Search Report issued March 30, 2005.

No item of information contained in the accompanying Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the undersigned person, after making reasonable inquiry, no item of information contained in the accompanying Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.

It is requested therefore that the Examiner consider this additional prior art in the examination of this continuation application.

Claim 1 has been amended to add the language specifically stated by the Examiner in lines 2 and 3 of page 6 of the Official Action.

Thus the Examiner has indicated that Claim 1, as previously filed, did NOT limit the claim in the manner argued by the Applicants and thus Claim 1 remained anticipated by the prior art.

It is clear now that Claim 1, as now amended, is limited in the manner indicated by the Examiner and thus is distinguished from the prior art by the feature as stated that:

the first and second substrate sheets being completely separate sheets which are subsequently joined together at said line;

which is not shown in Speyer, as indicated by the Examiner.

The Examiner has also maintained the rejection under 35 U.S.C.102 concerning the following features, which it is submitted, are, contrary to the Examiner's assertion, NOT shown in Speyer:

a) The line at which the first and second substrate sheets are fastened together is spaced from the side edges of the first substrate sheet so as to define two parts of the first substrate sheet one on each side of the line and the line is spaced from the side edges of the second substrate sheet as it defines two parts of the second substrate sheet one on each side of the line. If the Examiner is considering the sheet 2 as the first substrate sheet and the sheet 3 as the second substrate sheet, then these sheets are not fastened together along a line since they are fastened together over their whole area.

b) The four parts defined by the two parts of the first substrate sheet and the two parts of the second substrate sheet are separate each from the other such that each part can pivot relative to the other parts about an axis defined by the line. Clearly this is not the case in the construction of Speyer since firstly the two sheets are completely fastened together so that one part of sheet 2 cannot pivot relative to the adjacent part of sheet 3 since they are fastened together. Secondly in Speyer, in the finished product, as shown in Figure 1, the side edges are also fastened together so as to prevent any pivotal movement. The claim now clearly distinguishes from this construction.

c) The construction defined above forms a booklet of four parts and eight exposed surfaces. In Figure 2 of Speyer clearly there are not four parts and eight exposed surfaces since there are only two parts folded about the line 7.

The Examiner's ONLY argument concerning the disclosure of these features is that Speyer in paragraph 0017 states that "*the sealable material ...able to be sealed on any part of its surface*". The Examiner's position is that this statement justifies a conclusion that Speyer **discloses** any arrangement or pattern of two sheets sealed together that any person may propose. Thus, according to the Examiner's position, Speyer "**discloses**" designs such as polka dot pattern, or a series of stripes, or functional arrangements such as a complex array of pockets, or anything else which can be proposed now or at any future time, whether this be an invention or not. Based on this application of 35 U.S.C.102, no invention can ever be patented which relates to a pair of sheets sealed together because Speyer discloses every possible arrangement. This is clearly not a proper application of the principals of 35USC102.

At best, the Examiner's position is based on the principle set out in **paragraph 2112 of MPEP** that the above features are "**inherent**" in Speyer. In particular in sub paragraph IV of 2112 it is stated

"*The fact that a certain result or characteristic **may** occur or be present in the prior art is **not** sufficient to establish the inherency of that result or characteristic*" (emphasis added).

And

"In relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art" (emphasis NOT added).

Not only has the Examiner failed to provide such a basis but in addition it is contrary to the specific teaching of Speyer where in paragraph 0016 is stated:

"These films are joined... together at their periphery to form a wallet."

And in paragraph 117:

"It is advantageous for the said sealable material to be able to be sealed on any part of its surface to make it possible to vary the shape of the said medium as required"(emphasis added).

Taking these two sentences together it is fully clear that the whole teaching of Speyer is that the "medium" is a wallet with sealed edges and the sealing at any part of the surface makes the shape of the wallet (with sealed edges) variable. That is it can be square or circular or any other shape but it has sealed edges to make it a wallet.

Thus not only has the Examiner failed to provide a prima facie case on inherency as required in MPEP paragraph 2112 but also the features set forth above are not inherent for the reason set forth above.

The Examiner is advised that, as the Examiner's rejection under 35 U.S.C.102 is wholly inconsistent with the principles established under precedent and

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clearly set out in MPEP, the Applicant will file an Appeal on this basis if such rejection is maintained.

In view of the foregoing, further and favourable reconsideration of this application is respectfully requested.

Respectfully submitted

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Enc.(3)

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306, on April 28, 2005

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